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09/355,601	07/30/1999	David J. Kinning	54545USA6A	6681

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EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 12/18/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/355,601

Applicant(s)

Kinning et al

Examiner

T. Yoon

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 11-8-02, RCE
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-15, 18-20, 26-28, 31-35 and 38 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-15, 18-20, 26-28, 31-35 and 38 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Rejection is maintained for reason of record.

The instant examples 1-3 fall within the scope of the claimed composition, and the example 1 does not yield the recited peel adhesion value greater than about 10.0N/dm. Thus, the specification fails to teach adequately how to control the reaction in order to obtain such (claimed) polyurea-based polymer or what structural or process limitation control the claimed property (peel adhesion and shear strength) since said examples show random results of peel adhesion and shear strength.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-15, 18-20, 26-28, 31-35 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "essentially free of segments derived from polysiloxane polyamines" in claim 1 is indefinite since there is no definition of said essentially free of in the specification. The page 13 of the specification discloses "preferavly comprise less than about 75% [sic] weight percent of polysiloxane", "more preferavly less than about 75% [sic] weight percent" and "essentially free of --- most preferred". Said "essentially free of" is unclear since it could be any amount below 75 weight percent.

Claim 3 is confusing in view of claim 2 since claim 2 recites a tackifier, but claim 3 recites "up to about 45 parts" which encompasses zero parts. The examiner interprets that claim 2 includes zero parts.

Claim 4 improperly broadens the scope of claim 1 wherein less than 45 parts by weight tackifier is recited.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 19, 20, 26-28, 31, 33, 34 and 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 380 236 or Leir et al (US 5,214,119 or 5,461,134).

Rejection is maintained for reason of record and following.

Contrary to applicant's assertion, EP teaches that the copolymer comprises 5% to 95% of copolymeric segment at page 6, lines 40-41, and thus said teaching encompasses the instantly recited essentially free of segments derived from polysiloxane polyamines. See above rejection under 35 USC 112.

The instantly recited "less than 45 parts by weight tackifier" encompasses no tackifier at all, and thus the silicone-polyether polyurea copolymer and silicone-polyester polyurethane polyurea copolymer in the examples of EP and Leir et al meet the instant adhesive. Also, for example, the preamble "an adhesive" of claim 1 has little probative value and the claim 1 is directed to a composition comprising a polyurea-based polymer basically.

Examples 21-24 having a silicone polyurea and MQ resin in a ratio of 1:1 meet the claim 4.

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Claims 1-15, 19, 20, 26-28, 31-34 and 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 96/35458.

Rejection is maintained for reason of record and following.

EP teaches m (up to 1000), n (equal to 1) and p (about 10) [page 11, lines 3-5] for the polyorganosiloxane polyurea segmented copolymer formula at page 9 which meets the instant polyurea-based polymer essentially free of segments derived from polysiloxane polyamines.

The instantly recited "less than 45 parts by weight tackifier" encompasses no tackifier at all, and thus the polyorganosiloxane polyurea segmented copolymers in the examples meet the instant adhesive. Also, for example, the preamble "an adhesive" of claim 1 has little probative value and the claim 1 is directed to a composition comprising a polyurea-based polymer basically.

Lines 17-23, page 17 teach various amounts of the polyorganosiloxane polyurea segmented copolymer and the silicate resin.

Claims 1-15, 18-20, 26-28, 31-35 and 38 are rejected under 35 U.S.C. 103(a) as obvious over WO 96/35458 in view of WO 98/13135 or Wright et al (US 6,224,949 B1).

Rejection is maintained for reason of record, above and following.

Lines 17-23, page 17 teach various amounts of the polyorganosiloxane polyurea segmented copolymer and the silicate resin. Thus, the use of the instant amount of a tackifier would be obvious.

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Claims 1-3, 9-15, 19, 20, 26, 31, 32, 34 and 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hassel et al (US 5,047,272) or Starzewski et al (US 5,049,427)..

The instantly recited "less than and up to 45 parts by weight tackifier" encompasses no tackifier at all, and thus the polyurea copolymers of Hassel et al and Starzewski et al meet the instant adhesive. Also, for example, the preamble "an adhesive" of claim 1 has little probative value and the claim 1 is directed to a composition comprising a polyurea-based polymer basically.

Hassel et al teach the instant polyurea-based copolymers and a coated film thereof at col. 8, lines 21-57. Burden is on applicant to show that polyurea-based copolymers of Hassel et al do not have the recited properties since the claims do not recite any particular limitation with respect to the polyurea-based copolymers.

Starzewski et al teach the adhesive based on polyurea-based copolymers at col. 2, lines 41-52 and col. 4, lines 37-62.

Thus, the instant invention lacks novelty.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

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Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/December 12, 2002


TAE H. YOON
PRIMARY EXAMINER